

PATENT COOPERATION TREATY

PCT

REC'D 19 AUG 2004

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference PCT 21085Y	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US03/10740	International filing date (day/month/year) 08 April 2003 (08.04.2003)	Priority date (day/month/year) 12 April 2002 (12.04.2002)
International Patent Classification (IPC) or national classification and IPC IPC(7): A61K 31/335, 31/35; C07D 319/14, 311/74 and US Cl.: 514/366, 405; 549/452, 457		
Applicant MERCK & CO., INC.		

- 1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
- 2. This REPORT consists of a total of **4** sheets, including this cover sheet.

This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of **4** sheets.

EPO - DGI 1

3. This report contains indications relating to the following items:

19. 01. 2004

- I Basis of the report
- II Priority
- III Non-establishment of report with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

Date of submission of the demand 22 October 2003 (22.10.2003)	Date of completion of this report 09 July 2004 (09.07.2004)
Name and mailing address of the IPEA/US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230	Authorized officer  Raymond Covington Telephone No. (703) 308-1235

Form PCT/IPEA/409 (cover sheet)(July 1998)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/US03/10740

I. Basis of the report1. With regard to the elements of the international application:^{*}

- the international application as originally filed.
- the description:

pages 1-164 as originally filed
 pages NONE, filed with the demand
 pages NONE, filed with the letter of _____.
- the claims:

pages 165-188 as originally filed
 pages NONE, as amended (together with any statement) under Article 19
 pages NONE, filed with the demand
 pages NONE, filed with the letter of _____.
- the drawings:

pages NONE, as originally filed
 pages NONE, filed with the demand
 pages NONE, filed with the letter of _____.
- the sequence listing part of the description:

pages NONE, as originally filed
 pages NONE, filed with the demand
 pages NONE, filed with the letter of _____.

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- the language of publication of the international application (under Rule 48.3(b)).
- the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- contained in the international application in printed form.
- filed together with the international application in computer readable form.
- furnished subsequently to this Authority in written form.
- furnished subsequently to this Authority in computer readable form.
- The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- the description, pages NONE
- the claims, Nos. NONE
- the drawings, sheets/fig NONE

5. This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).^{**}

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

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III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

- the entire international application,
 claims Nos. 1-14 and 17-29

because:

- the said international application, or the said claim Nos. _____ relate to the following subject matter which does not require international preliminary examination (*specify*):
- the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____ are so unclear that no meaningful opinion could be formed (*specify*):
- the claims, or said claims Nos. _____ are so inadequately supported by the description that no meaningful opinion could be formed.
- no international search report has been established for said claims Nos. 1-14 and 17-29

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

- the written form has not been furnished or does not comply with the standard.
 the computer readable form has not been furnished or does not comply with the standard.

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V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. STATEMENT

Novelty (N) Claims 15 and 16 YESClaims NONE NOInventive Step (IS) Claims NONE YESClaims 15 and 16 NOIndustrial Applicability (IA) Claims 15 and 16 YESClaims NONE NO

2. CITATIONS AND EXPLANATIONS

Claims 15 and 16 lack an inventive step under PCT Article 33(3) as being obvious over Guillaumet et al US 5,420,132 in view of Guillaumet et al US 5,439,909. Guillaumet et al '132 teach substituted benzodioxins as recited in the claims. See, for example, column 1 lines 30-70 and column 2 lines 1-5 where R₃ is hydrogen and R₄ is alkyl, e.g. methylpropyl which is substituted with aryl. The reference differs from the recited claims in that chloro is not specifically disclosed as a substituent on the aryl, phenyl, group. However, Patentees, particularly in view of Guillaumet et al '909 teach analogous compounds, that the aryl groups may be optionally substituted and that these optional substituents include halogen, read chloro. See, for example Guillaumet et al '909 column 1 lines 30+, column 25 lines 10-60 particularly column 3 lines 5-15.

Claims 15-16 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.